

**REMARKS**

The claims are claims 1, 3 and 4.

Claims 1, 3 and 4 have been amended. Claim 2 is canceled. Claim 1 is amended to include the limitations previously recited in canceled claim 2. Claims 3 and 4 are amended to depend upon claim 1 rather than canceled claim 2.

Claims 1 (reciting subject matter previously claimed in claim 2), 3 and 4 were rejected under 35 U.S.C. 103(a) as made obvious by the combination of Itoh et al U.S. Patent No. 6,075,941 and Swoboda et al U.S. Patent No. 6,522,985.

Claim 1 recites subject matter not made obvious by the combination of Itoh et al and Swoboda et al. Claim 1 recites "selectively assigning control of at least one emulation resource of the integrated circuit to one of said serial scan path or said monitor program." The OFFICE ACTION states at page 3, line 18 to page 4, line 5:

"As per claim 2, Itoh discloses selectively assigning emulation resources to one of emulation program to monitor signals for the ICE to detect the operating state of the microcomputer (col. 3, lines 20-54) through trace control circuit (34) for tracing control registers and data buses or paths. Itoh does not expressly disclose serial scan path as claimed. Such feature is however well-known in the art. In fact, Swoboda teaches serial scan path for debugging and monitoring circuit emulation (Figs. 49, 50,, Abstract, Front page) to reduce emulation time and cost due to design change and grading as suggested in the Background of the invention."

The OFFICE ACTION cites Itoh et al for its teaching of emulation resources controlled by a monitor program. The OFFICE ACTION cites Swoboda et al for its teaching of a serial scan path for debugging and monitoring circuit emulation. However, the combination of Itoh et al and Swoboda et al fail to teach emulation resources selectively under control of a monitor program or the serial scan

path at recited in claim 1. The OFFICE ACTION fails to point out where the combination of Itoh et al and Swoboda et al makes obvious the selection of control of an emulation resource as claimed. Accordingly, claim 1 is allowable over the combination of Itoh et al and Swoboda et al.

Claim 3 recites subject matter not made obvious by the combination of Itoh et al and Swoboda et al. Claim 3 recites "said step of selectively assigning emulation resources of the integrated circuit assigns said emulation resources to said serial scan path upon a first digital state of said monitor privilege input and assigns said emulation resources to said emulation monitor program upon a second digital state of said monitor privilege input." The OFFICE ACTION states at page 4, lines 10 to 13:

"As per claim 3, Itoh discloses privilege input for monitor program, monitor of privilege input for the emulation program and assigning resources for emulation program and path tracing circuit. Swoboda teaches serial scan testability and emulation resource assignment to the circuit during circuit emulation as claimed."

The Applicant respectfully submits that though the OFFICE ACTION states that Itoh et al discloses a "privilege input for monitor program," Itoh et al includes no such disclosure. Applicant's attorney has searched Itoh et al for all disclosure of inputs and has found no input corresponding to the monitor privilege input recited in claim 3. Because the OFFICE ACTION fails to point out where Itoh et al discloses the claimed monitor privilege input, the OFFICE ACTION fails to make a *prima facie* case of unobviousness. The Applicant respectfully requests the Examiner to specifically designate the disclosure of Itoh et al which makes obvious the claimed monitor privilege input. If the Examiner is unable to point out this disclosure, the rejection of claim 3 should be withdrawn. In the absence of designation of the particular portion

of Itoh et al which makes obvious the claimed monitor privilege input, claim 3 is allowable over the combination of Itoh et al and Swoboda et al.

The Applicant respectfully submits that all the present claims are allowable for the reasons set forth above. Therefore early reconsideration and advance to issue are respectfully requested.

If the Examiner has any questions or other correspondence regarding this application, Applicant requests that the Examiner contact Applicant's attorney at the below listed telephone number and address to facilitate prosecution.

Texas Instruments Incorporated  
P.O. Box 655474 M/S 3999  
Dallas, Texas 75265  
(972) 917-5290  
Fax: (972) 917-4418

Respectfully submitted,

  
Robert D. Marshall, Jr.  
Reg. No. 28,527